

REMARKS

Claims 1, 4-5, and 7-41 are pending. Claims 1 and 4-5, 7-12, and 41 are currently under examination. Claims 2-3 were previously cancelled without prejudice or disclaimer. With this response, applicants have cancelled claim 6 without prejudice or disclaimer and applicants reserve the right to pursue the cancelled subject matter in the future. Claims 1 and 7-11 have been amended as explained below. Claims 13-40 are withdrawn from examination as being directed to non-elected subject matter. Claim 41 is a new claim added to capture specific compounds of claim 11. Upon allowance of claims 1, 4-5, 7-12, and 41 (claims directed to compounds and compositions) applicants exercise their right of rejoinder with respect to claims 13-40 (claims directed to methods of using the compounds and pharmaceutical compositions of claims 1, 4-5, 7-12, and 41). No new matter has been added into the claims.

Interview Summary

Applicants thank Examiner Stockton for discussing the Office Action dated December 24, 2008 by telephone with applicants' representative James Balls on April 21, 2009. Specifically, applicants' representative inquired about gaining priority to Provisional Application No. 60/504,214, filed on September 22, 2003, to overcome rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a). The examiner agreed that if applicants perfected their priority claim, the rejections based on Bressi *et al.*, U.S. Patent Application Publication No. 2005/0137234 ("Bressi *et al.*") would no longer apply. Bressi *et al.* claims priority to Provisional Application No. 60/531,371, filed on December 19, 2003, which is nearly three months *after* the filing of the earliest provisional application in this case, Provisional Application No. 60/504,214, filed on September 22, 2003. To perfect priority, the examiner indicated that all variables must be described and fully supported by the provisional applications and encouraged applicants to submit a written response specifically identifying the support in the provisional applications.

Priority

The application has been denied priority to Provisional Application No. 60/504,214 (filed September 22, 2003) and Provisional Application No. 60/530,890 (filed December 22, 2003). While not agreeing that the claims lack support in the provisional applications, applicants have amended the claims to more clearly reflect the subject matter described in the provisional applications.

Applicants have amended the “Z” moiety of claim 1 to be a double bond located at ring position 5 in the trans-configuration as described in claims 1-3 and the examples of Provisional Application No. 60/504,214.

Applicants have defined “R⁴” as “H” so that the right-hand side of the molecule now contains the group “-C(=O)NR₃OH,” as described in Formula I of Provisional Application No. 60/504,214.

Applicants have amended the definitions of “X and Y” to reflect the definitions provided in claim 1 of Provisional Application No. 60/504,214. Specifically, claim 1 of Provisional Application No. 60/504,214 provides:

X and Y are the same or different and are independently selected from the group consisting of hydrido, halo, C₁-C₄ alkyl, such as CH₃ and CF₃, NO₂, C(O)R⁴, OR⁵, SR⁵, CN and NR⁶R⁷.

The substituents “R⁴” to “R⁷” of Provisional Application No. 60/504,214 are shown as substituents “R⁵” to “R⁸” in the instant claims due to the addition of an R⁴ group earlier in the formula (which has been amended back to “H” in the instant claims). Accordingly, the instant claims provide for the identical substituents for “X and Y” in a slightly different order and format as shown below:

X and Y are the same or different and are independently selected from the group consisting of: H, halogen, -CN, -NO₂, -CF₃, C₁-C₄ alkyl, -COR⁵, -SR⁶, -OR⁶, and -NR⁷R⁸.

Applicants have amended the definition of “R³” to correspond to the definition of “R³” in claim 1 of Provisional Application No. 60/504,214.

Applicants have amended the definition of “R⁵” through “R⁸” so they correspond to the definitions provided for “R⁴” through “R⁷” in claim 1 of Provisional Application No. 60/504,214.

Claim 4 is equivalent to claim 4 of Provisional Application No. 60/504,214.

Claim 5 corresponds to claim 5 of Provisional Application No. 60/504,214 (except that the term “hydrido” has been replaced with the more commonly used term “H,” which represents the same chemical moiety).

Applicants have cancelled claim 6 because “R⁴” is now defined as “H” in claim 1.

Claims 7-8 correspond to a subset of variables from the definition of “R¹” in claim 1 and the examples of Provisional Application No. 60/504,214.

Claims 9-10 correspond to a subset of variables from the definition of “R²” in claim 1 and the examples of Provisional Application No. 60/504,214.

Claim 11 is directed to individual compounds. While all individual compounds of claim 11 are not explicitly disclosed or exemplified in Provisional Application No. 60/504,214, they fall within the genus of claim 1, which is described in Provisional Application No. 60/504,214.

Claim 12 is directed to pharmaceutical compositions as described on page 8 of Provisional Application No. 60/504,214.

Claim 41 is directed to individual compounds explicitly described on pages 14-15 in Table 1 of Provisional Application No. 60/504,214.

Response to Claim Objections

Claim 1 has been objected to for a variety of minor editorial reasons. Each objection is addressed in turn.

1. The Office Action objects to claim 1 because a space was missing after the moiety “-OR⁶” in three occurrences. Applicants have amended the claims by entering a space in each location identified by the examiner.
2. The Office Action objected to the multiple capitalizations of the word “Each” in claim 1. Applicants have deleted the objected terms and therefore the objection no longer applies and should be withdrawn.
3. The Office Action objected to the multiple capitalizations of the word “Wherein” in claim 1. Applicants have deleted the objected terms and therefore the objection no longer applies and should be withdrawn.
4. The Office Action objected to claim 1 for misspelling the word “alkoxyalkyl” in the definition of “Cy.” Applicants have amended claim 1 by deleting “Cy.” Therefore the objection no longer applies and should be withdrawn.
5. The Office Action objected to claim 8 for misspelling the word “imidazole-1-yl.” Applicants have amended claim 8 to remove the term and therefore the objection no longer applies and should be withdrawn.
6. The Office Action objected to claim 10 for including a comma after the phrase, “wherein R² is.” Applicants have amended claim 10 to remove the comma. Therefore the objection no longer applies and should be withdrawn.

Response to Rejection Under 35 U.S.C. § 112

Claims 1, 4-5, and 7-12 have been rejected under 35 U.S.C. § 112, second paragraph, as being unclear for a variety of reasons. Each reason is addressed in turn.

1. The Office Action rejected claim 1 for including a valence inconsistency with reference to the substituent “sulfonyl.” Applicants have amended claim 1 so that “R¹,” “R²,” “X,” and “Y” no longer include “sulfonyl.” Therefore, the rejection no longer applies and should be withdrawn.
2. The Office Action rejected claim 1 for omitting an “and” before the last substituent in the definition of “R³.” Due the amendments to the claims this objection no longer applies and should be withdrawn.
3. The Office Action rejected claim 1 for omitting a comma before the word “acyl” in the definitions of “X and Y.” Since applicants have cancelled the word “acyl,” a comma has been placed after the substituent “-OR⁶.” Accordingly, the objection no longer applies and should be withdrawn.
4. The Office Action rejected claim 1 for including differing definitions for “L¹” in claim 1. “L” has been deleted from the claims and therefore the rejection no longer applies and should be withdrawn.
5. The Office Action noted that an “and” is missing before the last substituent in the Markush group of claim 8. Applicants have amended claim 8 to include an “and” before the last substituent in the Markush group and therefore the objection should be withdrawn.
6. The Office Action noted that an “and” is missing before the last substituent in the Markush group of claim 9. Applicants have amended claim 9 to include an “and” before the last substituent in the Markush group and therefore the objection should be withdrawn.

7. The Office Action rejected claim 1 for omitting an “and” before the last compound in the Markush group of claim 11. Applicants have amended claim 11 to include an “and” before the last compound in the Markush group and therefore the objection should be withdrawn.

Response to Double Patenting Rejection

Claims 1 and 4-12 have been provisionally rejected over claims 85-108 of U.S. Patent Application No. 12/065,989 based on the non-statutory prohibition against obviousness-type double patenting. U.S. Patent Application No. 12/065,989 was filed *after* the instant application and therefore the instant application should be allowed to issue absent a terminal disclaimer when no more rejections remain. MPEP § 804(I)(B)(1) explains that:

If a ‘provisional’ nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. . . . If ‘provisional’ ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer.

Accordingly, the obviousness-type double patenting rejection should be withdrawn and the instant application allowed to issue.

Response to Rejection Under 35 U.S.C. § 102(e)

Claims 1, 4-9, and 12 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Bressi *et al.* Bressi *et al.* is intervening art that only applies if the instant application is denied the priority date of Provisional Application No. 60/504,214 (filed September 22, 2003). As discussed above claims 1, 4-9, and 12 are fully supported by Provisional Application No. 60/504,214 and therefore entitled to the priority date of September 22, 2003. Accordingly, Bressi *et al.* does not apply as prior art against these claims and the rejection should be withdrawn.

Response to Rejection Under 35 U.S.C. § 103(a)

Claims 1 and 4-12 have been rejected under 35 U.S.C. § 103(a) as being obvious over Bressi *et al.* As discussed above, Bressi *et al.* is intervening art that only applies if the instant application is denied the priority date of Provisional Application No. 60/504,214 (filed September 22, 2003). As discussed above, at least claims 1, 4-5, 7-10, 12, and 41 are fully supported by Provisional Application No. 60/504,214 and therefore entitled to the priority date of September 22, 2003. Claim 11 is directed to compounds that are not explicitly set forth in Provisional Application No. 60/504,214 but fall within the genus of compounds described therein. Furthermore, the specific, structurally unique compounds of claim 11 are not obvious over the compounds of Bressi *et al.* Therefore, the rejection does not apply should be withdrawn.

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 14090-00003-US1 from which the undersigned is authorized to draw.

Dated: June 24, 2009

Respectfully submitted,

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